



PATENT
ATTORNEY DOCKET NO.: 2039279-5013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Reissue Application of:
Jan Hendrik Mensen

U.S. Patent No.: 5,657,600
Issued August 19, 1997

Reissue Application Serial No.: 09/374,598

Filed: August 13, 1999

For: **WEB MEMBER FOR CONCRETE
FORM WALLS**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Examiner: Stephan, B.
Art Unit: 3635

RECEIVED
JUL 25 2003
IGROUP 3600

REPLY BRIEF PURSUANT TO 37 C.F.R. §1.193(b)(4)

Appellant submits this reply brief in response to the Examiner's Answer dated June 17, 2003, in the above-identified reissue application. In short, the Examiner's Answer ignores the numerous arguments presented in the appeal brief traversing the recapture rejection and hides behind the cloak of a new PTO policy that has been shown by Appellant's Brief to be, *inter alia*: (1) inconsistent with controlling Federal Circuit precedent; (2) improper for failing to consider the entire file history and failing to create a *prima facie* case of unpatentability; (3) inequitable for retroactive application the new version of 37 C.F.R. §104(c) not in effect at the time applicant responded to the reasons for allowance in the parent application; and (4) inapplicable to various patentably distinct claims sets, included claim 45, which is materially narrower in other aspects of the invention.

Rather than address the substance of Appellant's arguments, the Examiner's Answer merely repeats (nearly verbatim) the prior Office Action. In a transparent attempt to make this case a "test case," the Answer ignores Appellant's detailed arguments because it seeks to establish a "bright line" rule regarding reasons for allowance that is not supported by the law, nor even applicable to the facts of this case, even if it were a valid "rule." Accordingly, there is no need to address the substance of the Answer as it does not substantively respond to the detailed arguments made in the Appeal Brief. However, Appellant wishes to address two formality issues raised in the Answer.

First, with respect to Section 2 of the Examiner's Answer concerning Related Appeals and Interferences, Appellant is at a loss to understand the Examiner's statement on page 2 of the Answer alleging that the Appeal Brief "does not contain a statement identifying the related appeals and interferences" At page 1 of Appellant's Appeal Brief, Section 2, entitled "Related Appeals and Interferences, Appellant specifically notes that "Appellant is not aware of any other appeals or interferences that will directly affect, will be affected by, or will otherwise have a bearing on the decision in this appeal.

With respect to Section 7 of the Answer, Grouping of Claims, Appellant disagrees with the Examiner's statement that the rejection of claims 17-45 stand or fall together. While Appellant's Appeal brief failed to include a separate section on the grouping of claims, it is plainly apparent from the Summary of the Invention section and the Argument section of Appellant's brief, that not all the claims stand or fall together. Indeed, several arguments were presented applying to discrete claim groups. *Se*, Section 7D, which includes separate arguments with respect to claims 17-23 and 41-44 on the one hand, and claims 24-41, on the other hand, Section 7E, which includes separate arguments with respect to claims 17-23 and 42-45, and claims 24-45, respectively, and Appellant's Brief, Section 7F, which is explicitly directed solely to Claim 45, at pp. 9-12.

The MPEP makes clear that in order for the claims to be treated as standing or falling together, an appeal brief must lack both: (a) a statement that the claims do not stand or fall

together; and (b) arguments why the claims subject to the same rejection are separately patentable. *See MPEP §1206 at pp. 1200-10 to 1200-11.* In this case, Appellant's brief clearly contains numerous arguments supporting separate patentability of distinct groups of claims. Accordingly, there is no basis for the Examiner's unfounded allegation that the claims stand or fall together.

Appellant submits below the following Grouping of Claims section and a chart to aid in clarifying which arguments in the Appeal Brief apply to which group of claims.

GROUPING OF CLAIMS

Claims 17-45 include 8 independent claims (17, 23, 24, 41, 42, 43, 44 and 45) and numerous claims dependent upon some of the independent claims. Not all of the claims stand or fall together for purposes of this appeal, although several arguments made in the Argument section are applicable to all claims. In particular, for purposes of this appeal, there are four separately patentable groups of claims:

Group 1: Claims 17-23 and 42, directed to the details of the novel bridging member design, either alone or in combination with a building component. Claims 17, 23 and 42 in this group are independent.

Group 2: Claims 24-40 and 43, directed to a building component defining a supporting shelf. Claims 24 and 43 in this group are independent.

Group 3: Independent claims 41 and 44, directed to a building component having the details of the novel bridging member design and also defining a supporting shelf.

Group 4: Independent claim 45, directed to an insulating wall including first and second building components, a wall and a finger formed by building material defining, in part, a supporting shelf.

The chart below specifies which arguments in the Argument Section of the Appeal Brief are applicable to which groups of claims.

Argument Heading	Appeal Brief Page No.	Groups & Claim Groups
A	6-7	Groups 1-4 (Claims 17-45)
B	7	Groups 1-4 (Claims 17-45)
C	8-9	Groups 1-4 (Claims 17-45)
D	p. 9, line 26 through p. 11, line 5	Group 1 (Claims 17-23, 42) Group 3 (Claims 41, 44)
D	p. 11, lines 6-12	Group 2 (Claims 24-40, 43) Group 3 (Claims 41,44)
E	p. 11, lines 19-26	Group 1 (Claims 17-23, 42) Group 3 (Claims 41,44)
E	p. 12, lines 1-8	Group 2 (Claims 24-40, 43) Group 3 (Claims 41,44)
F	p. 12, line 9-23	Group 4 (Claim 45)

For the convenience of the Examiner and the Board, Appellant has incorporated the above Grouping of Claims section into an Amended Appeal Brief, which also provides subheadings in the Argument section explicitly identifying which claim groups apply to which arguments. During preparation of the Amended Appeal Brief Appellant's undersigned representative noted certain obvious errors in the identification of claims in some of the individual argument sections of the original Appeal Brief and has corrected them in the enclosed

amended version. The Amended Appeal Brief, however, does not change the substance of Appellant's arguments, but merely provides the required Grouping of Claims section in the correct order and conforms the Summary of the Invention and Argument sections to the Grouping of Claims.

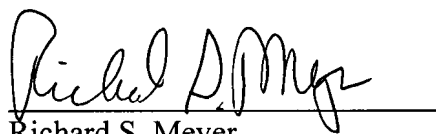
As no new arguments have been presented in the Amended Appeal Brief, the Examiner's Answer need not be supplemented and entry of the Amended Brief does not require further consideration and/or argumentation from the Examiner. Accordingly, Appellant respectfully requests entry of this Reply Brief and the Amended Appeal Brief into the record and prompt notification thereof. (For the Board's convenience, three copies of the Amended Appeal Brief with the same appendices as the original appeal brief are submitted herewith.)

Appellant respectfully requests that the case is ready to be transferred to the Board and requests that it be treated with special dispatch given its nature as a "reissue" application.

Respectfully submitted,
MCGUIREWOODS LLP

Date: July 21, 2003

By:



Richard S. Meyer
Registration No. 32,541

Customer No. 23345
McGuireWoods LLP
1750 Tysons Boulevard, Suite 1800
McLean, Virginia 22102-4215
Tel: 703.712.5000
Fax: 703.712.5427